

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/582,522	08/24/00	MAQR	Z 00654759

DANIEL H SHULMAN  
MAYER BROWN & PLATT  
PO BOX 2828  
CHICAGO IL 60690-2828

HM12/1024

EXAMINER

BERMAN, A

ART UNIT	PAPER NUMBER
----------	--------------

1619

DATE MAILED:

10/24/01

Pl ase find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/582,522

Applicant(s)

MAOR ET AL.

Examiner

Alysia Berman

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 8 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-6, in Paper No. 8 is acknowledged.
2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### ***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Response to Amendment***

4. The preliminary amendment filed August 24, 2000 is objected to because the paragraph inserted at page 5, line 2 after "DETAILED DESCRIPTION OF THE INVENTION" refers to a preferred embodiment of the invention taken in conjunction with the appended drawings. However, no drawings were found in the file.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1619

7. The use of the phrase "and/or" in line 3 of claim 1 renders the claim indefinite. It is unclear what combination of ingredients are required by the claim. Does the claim require Dead Sea water and either a hydrophobic agent or a hydrophilic agent plus all of the other ingredients in the claim or does the claim require either Dead Sea water and a hydrophobic agent or a hydrophilic agent, solubilizers, gelling agents, viscosity modifiers and deionized water?

8. Claim 1 is indefinite because it uses the term Dead Sea water but, according to the specification, does not appear to require water obtained from the Dead Sea. The salt content of water obtained from the Dead Sea is very specific and considered unique. Therefore, the use of any other definition of "Dead Sea water" is repugnant. Does Applicant intend to claim water that was obtained from the Dead Sea or water that contains a total dissolved salt (TDS) content that resembles that of Dead Sea water? Amendment of the claim to recite water with the particular TDS disclosed at page 6, lines 20-22 would overcome this rejection.

9. Claim 5 is indefinite because it is unclear what is required by the claim. The phrase "up to" includes zero as a lower limit. *In re Mochel*, 470 F2d. 638, 176 USPQ 194 (CCPA 1974). By the use of the phrase "up to", claim 5 appears not to require a solubilizer, a hydrophilic agent, a hydrophobic agent or a fragrance. However, the claim depends from claims that appear to require either a hydrophilic or hydrophobic agent, solubilizers, fragrances and antioxidants.

10. Claim 6 is indefinite because it is unclear what Applicant intends to encompass by the abbreviations BHA, BHT and EDTA. All claim limitations, even if well known,

Art Unit: 1619

should be fully written out the first time they appear in the claims with any abbreviations in parentheses afterward for subsequent use.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/16155 (155).

WO '155 is directed to cosmetic compositions (title and abstract). For Dead Sea water, deionized water, vegetable oils (wheat germ, lavender and jojoba oils), tocopherol (vitamin E), gelling agents or viscosity modifiers (carbomer), solubilizers (emulsifying vegetable wax), antioxidants and alpha-hydroxy acids, fragrances, and lavender oil and various vitamins, humectants, plant extracts (aloe vera gel), anti-irritant agents and moisturizing agents, see composition A at page 7, lines 13-19. For the art-recognized antioxidant BHT, see page 4<sup>th</sup> paragraph, page 6, last paragraph and page 7, line 23. See page 8, lines 3-9 for various additional common cosmetic ingredients that encompass the broad functional terms humectant, anti-irritant, moisturizing agent, solubilizers, gelling agents and viscosity modifiers as instantly claimed. See claim 5 for gels. Because the reference does not limit the type of gel, it encompasses clear liquid gels as instantly claimed.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/9716155 (155).

WO '155 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach the weight percent ranges of instant claim 5. It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. Therefore, absent evidence of unexpected results, the weight percent ranges are not considered critical to the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of WO '155 using optimal weight percents of

Art Unit: 1619

ingredients with the reasonable expectation of obtaining thickened cosmetic composition that enhances repair of sun exposure damage.

16. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/16155 (155) in combination with US 4,749,463 (563).

WO '155 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach the specific solubilizers and gelling agents or viscosity modifiers of claim 3.

US '563 is directed to skin care compositions (title and abstract). US '563 teaches that tween-20 and tween-80 are conventionally used in skin care compositions as solubilizer (col. 3, lines 32-39 and col. 4, lines 14-15). Magnesium aluminum silicate, hydroxyethyl cellulose, hydroxypropyl cellulose and xanthan gum are taught as common thickeners in skin care compositions at column 3, line 60 to column 4, line 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of WO '155 using the solubilizers and thickeners taught by US '563 with the reasonable expectation of obtaining a solubilized, thickened skin care composition.

### ***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached during core hours.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers

Art Unit: 1619

for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
October 17, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600